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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/486,262    06/12/00    UCHIDA

K    99807MN

000466

QM12/0914

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EXAMINER

JIMENEZ, M

ART UNIT

PAPER NUMBER

3726

9

DATE MAILED: 09/14/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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# Office Action Summary

Application No.

09/486,262

Applicant(s)

UCHIDA ET AL.

Examiner

Marc Jimenez

Art Unit

3726

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. **Claim 2** is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is unclear how one shaft (ie. "a rotary shaft") can be inserted from two opposite end faces of the cylindrical roller.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claims 8-23** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 recites "the hydraulic composition" in line 3 which lacks proper antecedent basis. Claim 8 recites "the adjacent cylindrical molded bodies" in lines 5-6 which lacks proper antecedent basis.

Claim 10 recites “the hydraulic composition” in line 3 which lacks proper antecedent basis. Claim 10 recites “the adjacent cylindrical green molded bodies” in lines 5-6 which lacks proper antecedent basis. Claim 10 recites “the cylindrical roller portion” in lines 8-9 which lacks proper antecedent basis.

Claim 12 recites “the paper feed roller” in line 1 which lacks proper antecedent basis.

Claim 13 recites “the cylindrical molded bodies” in line 2 which lacks proper antecedent basis.

Claim 18 recites “the hydraulic composition” in line 2 which lacks proper antecedent basis. Claim 18 recites “the molded bodies” in line 2 which lacks proper antecedent basis.

Claim 18 recites “the cylindrical green molded bodies” in line 2 which lacks proper antecedent basis.

Claim 19 recites “the cylindrical molded bodies” in line 2 which lacks proper antecedent basis.

The above are just examples of 35 USC 112 2<sup>nd</sup> paragraph problem in the claims and appropriate correction is required in all instances. There are numerous recitations of improper antecedent basis in the claims and applicant is requested to carefully review each claim accordingly.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. **Claims 1 and 2** are rejected under 35 U.S.C. 102(b) as being anticipated by Yabushita et al. (JP410017162A).

Yabushita et al. teach a paper feed roller comprising a rotary shaft **2**, a cylindrical roller portion **1** integrated with an outer periphery of the rotary shaft **2**.

The method of forming the device (ie. "formed by press molding a hydraulic composition, followed by curing and hardening") is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight.

Note that the rotary shaft **2** is constituted by two rotary shaft portions (the end portions of the shaft **2**) and the two rotary shaft portions are aligned with each other and axially inwardly inserted integrally into central portions of respective opposite end faces of the cylindrical roller portion from opposite sides such that the rotary shaft portions are concentric with an outer peripheral face of the cylindrical portion **1**.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 3, 5, and 8-11** are rejected under 35 U.S.C. 103(a) as being unpatentable over Yabushita et al. in view of Clements (2,658,262).

Yabushita et al. teach the invention cited above with the exception of the cylindrical portion being a plurality of bodies in a direction of the rotary shaft.

Clements teaches a plurality of bodies **B1** in a direction of a rotary shaft **B**.

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Yabushita et al. with a plurality of bodies in a direction of a rotary shaft, in light of the teachings of Clements, in order to provide a cylindrical portion that can be easily repaired.

Note that Clements teaches end portions of the cylindrical bodies **B1** have interengaging shapes **B2**, and the cylindrical bodies **B1** are connected by engagement at the end portions **B2**.

Note that Clements teaches forming a plurality of cylindrical molded (col. 2, lines 9-10) bodies **B1** each having a hole (see fig. 2-3) at a central portion through molding a hydraulic composition ("rubber" col. 2, lines 9-10), and releasing, curing and hardening the molded bodies (it is inherent in molding operations that releasing, curing and hardening of the molded bodies occur), inserting a rotary shaft **B** through the holes of a plurality of the cylindrical molded bodies **B1**, connecting the adjacent cylindrical molded bodies **B1**, and thereby integrally forming a cylindrical roller portion around the outer peripheral surface of the rotary shaft **B**,

With respect to Claims 10 and 11, Yabushita et al./Clements teach the invention cited above with the exception of the bodies being green. It would have been obvious to one of ordinary skill in the art, at the time of the invention, that the particular color of the bodies is clearly a matter of design choice, wherein no significant problems are solved by using green

molded bodies versus the molded bodies in the prior art. Also, there appears to be no particular benefit of using green molded bodies versus just molded bodies and without a showing of unexpected results, this is deemed a matter of obvious design choice. Also, official notice is taken that it is well known in the art to use green molded bodies.

9. **Claim 4** is rejected under 35 U.S.C. 103(a) as being unpatentable over Yabushita et al. in view of Clements as applied to **Claim 3** above, and further in view of Sukenik (4,542,566).

Yabushita et al./Clements teach the invention cited above with the exception of having a connecting core rod extending over two cylindrical bodies.

Sukenik teaches a connecting core rod **24** extending over two cylindrical bodies **14**.

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Yabushita et al./Clements with a connecting core rod extending over two cylindrical bodies, in light of the teachings of Sukenik, in order to securely connect each cylindrical body.

10. **Claims 6 and 7** are rejected under 35 U.S.C. 103(a) as being unpatentable over Yabushita et al.

Yabushita et al. teach the invention cited above with the exception of using the claimed composition.

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have used the claimed composition, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a

matter of obvious design choice. *In re Leshin*, 125 USPQ 416. Official notice is taken that it is well known to use the claimed composition.

11. **Claims 12-14 and 18-20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Yabushita et al. in view of Link (5,548,897).

Yabushita et al. teach the invention cited above with the exception of attaching two rotary shaft portions to opposite end portions of the cylindrical roller portion in the state while the two rotary shaft portions are concentric with the outer peripheral surface of the cylindrical roller portion, the two rotary shaft portions are aligned with each other, and thereby forming a rotary shaft by the two rotary shaft portions.

Link teaches attaching two rotary shaft portions **35** to opposite end portions of the cylindrical roller portion **20** in the state while the two rotary shaft portions **35** are concentric with the outer peripheral surface of the cylindrical roller portion **20**, the two rotary shaft portions **35** are aligned with each other, and thereby forming a rotary shaft by the two rotary shaft portions **35**.

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Yabushita et al. with attaching two rotary shaft portions to opposite end portions of the cylindrical roller portion in the state while the two rotary shaft portions are concentric with the outer peripheral surface of the cylindrical roller portion, the two rotary shaft portions are aligned with each other, and thereby forming a rotary shaft by the two rotary shaft portions, in light of the teachings of Link, in order to reduce the weight of the shaft.



With respect to Claims 14 and 20, Yabushita et al./Link teach the invention cited above with the exception of attaching the rotary shaft to the cylindrical roller portion by screwing. Official notice is taken that it is well known in the art to use screwing in attaching operations.

With respect to Claim 18, Yabushita et al./Link teach the invention cited above with the exception of the bodies being green. It would have been obvious to one of ordinary skill in the art, at the time of the invention, that the particular color of the bodies is clearly a matter of design choice, wherein no significant problems are solved by using green molded bodies versus the molded bodies in the prior art. Also, there appears to be no particular benefit of using green molded bodies versus just molded bodies and without a showing of unexpected results, this is deemed a matter of obvious design choice. Also, official notice is taken that it is well known in the art to use green molded bodies.

12. **Claims 15, 17, 21, and 23** are rejected under 35 U.S.C. 103(a) as being unpatentable over Yabushita et al. in view of Link as applied to **Claims 12 and 18** above, and further in view of Clements.

Yabushita et al./Link teach the invention cited above with the exception of the cylindrical portion being a plurality of bodies.

Clements teaches a plurality of bodies **B1** connected to a rotary shaft **B**.

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Yabushita et al./Link with a plurality of bodies for the cylindrical portion, in light of the teachings of Clements, in order to provide a cylindrical portion that can be easily repaired.

13. **Claims 16 and 22** are rejected under 35 U.S.C. 103(a) as being unpatentable over Yabushita et al. in view of Link and Clements as applied to **Claim 15** above, and further in view of Sukenik.

Yabushita et al./Link/Clements teach the invention cited above with the exception of having a connecting core rod extending over adjacent cylindrical bodies.

Sukenik teaches a connecting core rod **24** extending over adjacent cylindrical bodies **14**.

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Yabushita et al./Link/Clements with a connecting core rod extending over adjacent cylindrical bodies, in light of the teachings of Sukenik, in order to securely connect each cylindrical body.

#### ***Contact Information***

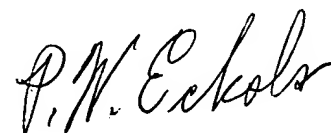
14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Jimenez whose telephone number is (703) 306-5965. The examiner can normally be reached on Monday-Thursday and alternate Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3579 for regular communications and (703) 305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5648.

MJ  
September 13, 2001



**P. W. Echols**  
Primary Examiner